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10/037,005	12/21/2001	William R. Matz	36968/267872	5691

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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/037,005

Applicant(s)

MATZ ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41, 44-46, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41, 44-46, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Miscellaneous

1. Please note that the examiner of record has changed.

Response to Amendment

1. This action is responsive to an Amendment filed 8/01/2006. Claims **1-41, 44-46, 49, 50** are pending. Claims **1-13, 15-27, 29-33, 35, 36, 38, 39, 41, 44, 46, 50** are amended. Claims **42, 43, 47, 48** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **1-41, 44-46, 49, and 50**, filed 8/01/2006, have been fully considered, but they are not persuasive in view of the statements below regarding Applicant's claim of priority.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged; however, Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of nonprovisional application No. 11/154,248, filed June 16, 2005 under 35 U.S.C. 120; however, 37 CFR § 1.78 (a)(1) states:

“A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more *prior-filed* copending nonprovisional applications or international applications designating the United States of America...” (italicized for emphasis).

The examiner notes that the subject application, Application No. 10/037,005, was filed on 12/21/2001. Therefore, Application No. 11/154,248, filed 6/16/2005, is not a prior-filed nonprovisional application of which the applicant can claim benefit. As such, the examiner does not grant benefit to the application and addresses the claims in the Office Action below based on the 12/21/2001 filing date of the subject application.

Furthermore, the examiner notes that the benefit claim is not timely. As stated in 37 CFR § 1.78 (a)(2)(ii):

“... reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application.”

As indicated by the examiner above, the benefit claim is not to a prior-filed application. Even if it was; however, benefit must be claimed within sixteen months from the filing date of the prior-filed application or within four months from the filing date of the subject application, both of which have expired.

Specification

1. The disclosure is objected to because of the following informalities:

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The amendment filed 8/01/2006 is objected to under 35 U.S.C. 132(a), because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure is as follows:

“This application relates to Attorney Docket No. 36968-265386 (BS01341), filed by Matz et al. on December 14, 2001, entitled ‘System and Method for Utilizing Television Viewing Patterns,’ which is incorporated herein by reference. This application also relates to Attorney Docket No. 36968-265387 (BS01342) filed by Matz et al. on December 14, 2001, entitled ‘System and Method for Identifying Desirable Subscribers,’ which is incorporated herein by reference. This application also relates to U.S. Application Serial No. 09/496825, filed February 1, 2000, which is incorporated herein by reference.”

Applicant is required to cancel the new matter in the reply to this Office Action.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims **49** and **50** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Referring to claims **49** and **50**, the examiner notes that both claims 49 and 50 depend from cancelled claim 47. The examiner recommends that the claims be changed to depend from claim 46. The examiner addresses the claims in the Office Action below as though the recommended changes have been made.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-41, 44-46, 49, and 50** are rejected under 35 U.S.C. 102(e) as being anticipated by Vinson et al.

Referring to claim **1**, Vinson et al. discloses a method for receiving subscriber content choice information, comprising:

- collecting subscriber content-choice data from a plurality of subscriber content-choice databases (p. 7, paragraphs 95, 101); and
- storing the subscriber content-choice data in a database 1114 (p. 7, paragraph 102 & Fig. 11).

Referring to claims **2** and **16**, Vinson et al. discloses the method of claims 1 and 15, respectively, wherein the subscriber content-choice data comprises data relating to viewing

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preferences of at least one subscriber (p. 6, paragraph 84, lines 1-4 & p. 8, paragraph 111, lines 1-5).

Referring to claims 3 and 17, Vinson et al. discloses the method of claims 2 and 16, respectively, wherein the subscriber content-choice data comprises data relating to a television program received by the at least one subscriber (p. 6, paragraphs 82, 83).

Referring to claims 4 and 18, Vinson et al. discloses the method of claims 3 and 17, respectively, wherein the subscriber content-choice data comprises at least one of data information and time information related to the television program (p. 6, paragraph 83, lines 1-3, 13-16).

Referring to claims 5 and 19, Vinson et al. discloses the method of claims 2 and 17, respectively, wherein the subscriber content-choice data further comprises data relating to the at least one subscriber (p. 6, paragraph 84).

Referring to claims 6 and 20, Vinson et al. discloses the method of claims 5 and 19, respectively, wherein the data relating to the at least one subscriber comprises a subscriber identifier for a subscriber (p. 21, paragraph 304).

Referring to claims 7 and 21, Vinson et al. discloses the method of claims 5 and 19, respectively, wherein the data relating to the at least one subscriber comprises demographic data for a subscriber (p. 8, paragraph 114).

Referring to claims 8 and 22, Vinson et al. discloses the method of claims 2 and 17, respectively, wherein the subscriber content-choice data further comprises data relating to a subscriber system (p. 7, paragraph 97).

Referring to claims 9 and 23, Vinson et al. discloses the method of claims 8 and 22, respectively, wherein the data comprises a cable system operator providing content to the subscriber system (p. 6, paragraph 85, lines 3-7; p. 7, paragraphs 98-103; & p. 22, paragraphs 320, 321).

Referring to claims 10 and 24, Vinson et al. discloses the method of claims 1 and 15, respectively, wherein the subscriber content-choice data comprises data relating to an advertisement received by at least one subscriber (p. 21, paragraph 306, lines 1-8).

Referring to claims 11 and 25, Vinson et al. discloses the method of claims 1 and 15, respectively, wherein the subscriber content-choice data comprises data relating to a viewing pattern of at least one subscriber (p. 12, paragraph 171, lines 9-13).

Referring to claims 12 and 26, Vinson et al. discloses the method of claims 1 and 15, respectively, wherein the subscriber content-choice data comprises at least one subscriber classification (p. 8, paragraph 114, lines 1-5).

Referring to claims 13 and 27, Vinson et al. discloses the method of claims 1 and 15, respectively, wherein the subscriber content-choice data comprises content-choice summary data (a summary of behavioral actions that a specific group demonstrated can be generated in response to queries like "How many African Americans in Florida watched at least 20% ...")(p. 6, paragraph 90).

Referring to claims 14 and 28, Vinson et al. discloses the method of claims 1 and 15, respectively, further comprising sorting the collected subscriber content-choice data (p. 8, paragraph 112, lines 1-6 & paragraph 113, lines 1-3).

Referring to claims **15** and **38**, Vinson et al. discloses a method/computer-readable medium for receiving and distributing content-choice information, comprising:

- collecting subscriber content-choice data from a plurality of subscriber content-choice databases (p. 7, paragraphs 95, 101);
- sorting the subscriber content-choice data in a database 1114 (p. 7, paragraph 102 & Fig. 11);
- retrieving stored subscriber content-choice data (p. 7, 8, paragraphs 104, 105); and
- providing the retrieved subscriber content-choice data to a requesting party (p. 8, paragraph 105).

Referring to claims **29** and **39**, Vinson et al. discloses the method/computer-readable medium of claims **15** and **38**, respectively, further comprising retrieving the selected subscriber content-choice data from the database (p. 8, paragraph 105).

Referring to claims **30** and **40**, Vinson et al. discloses the method/computer-readable medium of claims **15** and **38**, respectively, wherein the selected subscriber content-choice data is securely provided to the requesting party (p. 7, paragraph 99).

Referring to claim **31**, Vinson et al. discloses the method of claim **15**, wherein the stored subscriber content-choice data is selected based on subscriber geographic location detail (p. 6, paragraph 90).

Referring to claim **32**, Vinson et al. discloses the method of claim **15**, wherein the stored subscriber content-choice data is selected based on subscriber classification data (p. 6, paragraph 90).

Referring to claim **33**, Vinson et al. discloses the method of claim 15, wherein the stored subscriber content-choice data is selected based on data relating to television programs viewed by a plurality of subscribers (p. 6, paragraph 90).

Referring to claim **34**, Vinson et al. discloses the method of claim 15, wherein the stored subscriber content-choice data is selected based on data relating to advertisements viewed by a plurality of subscribers (p. 21, paragraph 304, lines 1-8).

Referring to claim **35**, Vinson et al. discloses the method of claim 15, wherein the stored subscriber content-choice data is selected based on at least one of a viewing date and a geographic location (p. 22, paragraph 320, lines 1-11).

Referring to claim **36**, Vinson et al. discloses a computer-readable medium 1105, 1106 on which is encoded computer program code for receiving subscriber content-choice information (Fig. 11), comprising:

- program code for collecting subscriber content-choice data from a plurality of subscriber content-choice databases (p. 8, paragraph 112, lines 1-6; p. 8, paragraph 113, lines 1-3; & Fig. 3); and
- program code for storing the subscriber content-choice data in a database (Fig. 11).

Referring to claim **37**, Vinson et al. discloses the computer-readable medium of claim 36, further comprising program code for sorting the collected subscriber content-choice data (p. 8, paragraph 113, lines 1-3).

Referring to claim **41**, Vinson et al. discloses a system for receiving and distributing content-choice information (Fig. 11), comprising a processor (Web Database Server 1117) communicating with a database stored in memory (Replicated Internet Database 1113), the

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database receiving subscriber content-choice data (p. 7, paragraphs 95, 101) and providing selected subscriber content-choice data to a requesting party (p. 8, paragraph 105).

Referring to claim **44**, Vinson et al. discloses the system of claim 41, wherein the system receives the subscriber content-choice database from a plurality of subscriber content-choice databases (p. 7, paragraphs 95, 101).

Referring to claim **45**, Vinson et al. discloses the system of claim 41, wherein the selected subscriber content-choice data is provided to the requesting party over the internet (p. 8, paragraph 105 & Fig. 11).

Referring to claim **46**, Vinson et al. discloses a system for receiving and distributing content-choice information, comprising a processor (Web Database Server 1117) communicating with a database stored in memory (Replicated Internet Database 1113), wherein the processor receives subscriber content-choice data from at least one subscriber content-choice database (p. 7, paragraphs 95, 101), and wherein the processor stores the subscriber content-choice data in the database (p. 7, paragraph 104).

Referring to claim **49**, see the rejection under 35 U.S.C. § 112, second paragraph above. Vinson et al. discloses the system of claim 46, further comprising a content provider terminal (Fig. 11).

Referring to claim **50**, see the rejection under 35 U.S.C. § 112, second paragraph above. Vinson et al. discloses the system of claim 49, wherein the processor retrieves selected subscriber content-choice data from the database and provides the selected subscriber content-choice data to the content provider terminal (Fig. 11).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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